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IN THE

Supreme Court of the United States

October Term, 1941

No. 233

314-645

FREDERIC H. PENN, doing business under the name and style of SUPERLITE COMPANY,

Petitioner,

vs.

NOVADEL-AGENE CORPORATION,

Respondent.

TEX-O-KAN FLOUR MILLS COMPANY,

Petitioner,

vs.

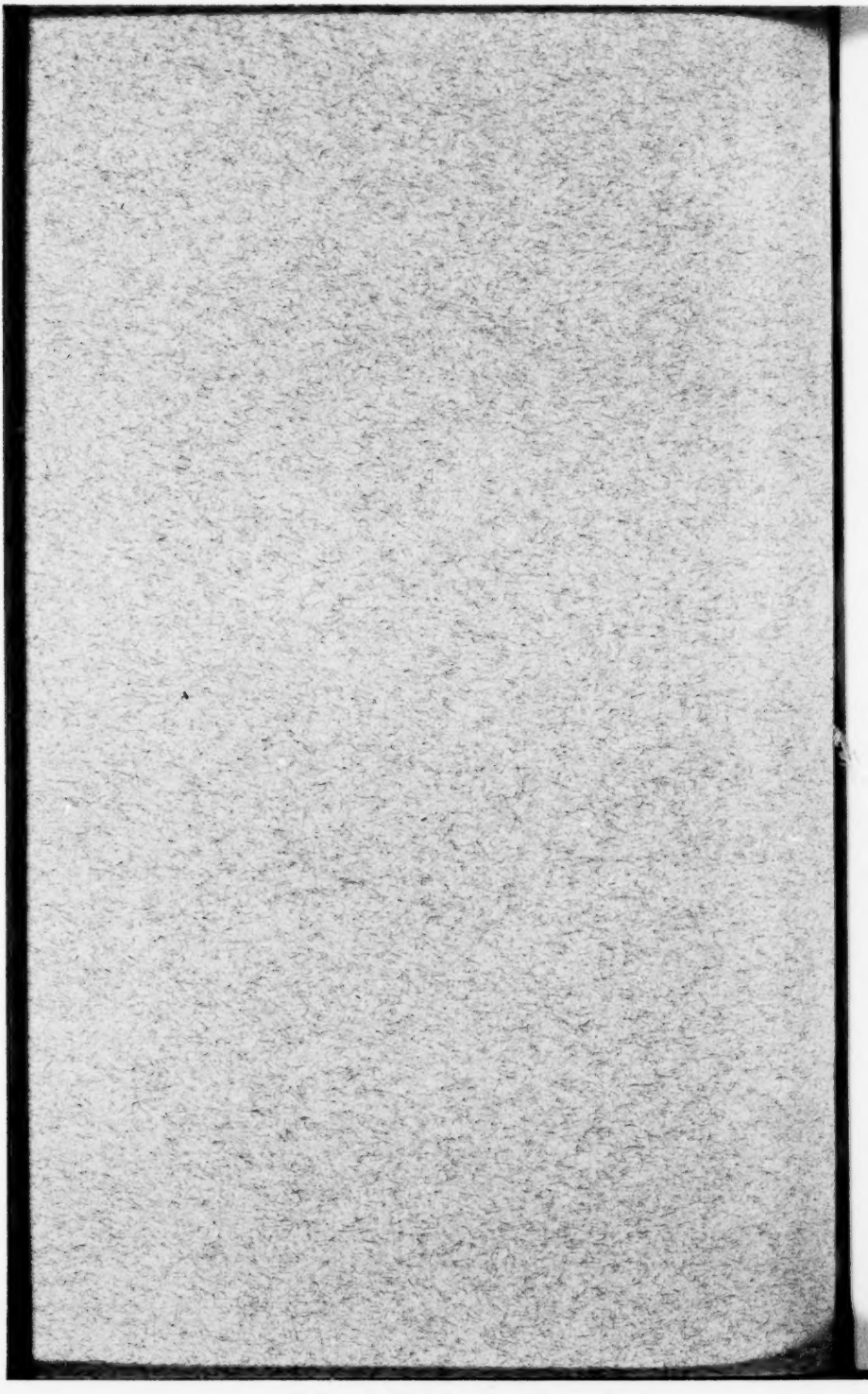
NOVADEL-AGENE CORPORATION,

Respondent.

PETITION OF FREDERIC H. PENN AND TEX-O-KAN FLOUR MILLS COMPANY FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT, AND BRIEF IN SUPPORT THEREOF.

SAMUEL E. DARBY, JR.,
Counsel for Petitioners.

ROBERT A. RITCHIE,
LOUIS D. FLETCHER,
Of Counsel.



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PETITION OF FREDERIC H. PENN AND TEX-O-KAN FLOUR MILLS COMPANY FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, Frederic H. Penn and Tex-O-Kan Flour Mills Company, respectfully pray for a writ of certiorari to the Circuit Court of Appeals for the Fifth Cir-

cuit, to review the judgment of that Court entered on the 16th day of May, 1941 (petition for rehearing denied June 16, 1941). A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with the rules of this Court.

Summary and Short Statement of the Matter Involved.

1. Respondent (plaintiff below), Novadel-Agene Corporation, is the owner of Sutherland Patent No. 1,539,701, directed to the alleged "process" of mixing an unpatented powdered, chemical compound with an edible cereal, such as flour, to bleach the flour and improve its baking qualities; as well as the composition of matter comprising the "mixture" formed of the flour and the unpatented chemical compound (R. 247).

2. Respondent was likewise the owner of a prior patent (No. 1,380,334) issued to the same patentee, Sutherland, which was reissued as Patent No. 16,116, and which expired on May 31, 1938. This expired patent also was directed to the same "process" of mixing the same powdered, chemical compound with an edible cereal, such as flour, to bleach the flour and improve its baking qualities; as well as the composition of matter comprising the "mixture" formed of the flour and the same chemical compound (R. 365).

3. Although the applications of Sutherland for these two separate patents for the same invention were copending in the Patent Office, and all of the claims in the application for the patent which issued as No. 1,539,701 were allowed on January 24, 1921, whereby both patents could have

been issued at the same time, respondent deliberately refrained from allowing the second application to issue as a patent for a period of more than four years thereafter, to thereby prolong the monopoly of the patent for that period of time after the expiration of the reissue patent (File History, Defendant's Exhibit 5, Physical).

4. After the expiration of the Sutherland reissue patent on May 31, 1938, petitioner, Frederic H. Penn, engaged in the manufacture of a chemical compound (commercially identified by the name "Superlite"), and the sale thereof to flour millers throughout the United States for use in bleaching and improving the baking qualities of the flour produced by them.

5. Petitioner's "Superlite" product was different from and superior to any bleaching compound available on the market, enabling the millers to effect a saving of 66⅔% in the cost of bleaching composition, and a reduction of the ash content in the flour (a deleterious content upon the quantative presence of which the flour is graded) from 1/100th of a per cent to 1/1000th of a per cent (R. 154).

6. On August 16, 1940, respondent instituted suit against petitioner, Frederic H. Penn, in the United States District Court for the Northern District of Texas, charging *contributory* infringement of the Sutherland Patent No. 1,539,701, by reason of his manufacture and sale of "Superlite" (R. 2-12).

7. On December 11, 1940 respondent instituted suit in the same Court against petitioner, Tex-O-Kan Flour Mills Company—a miller customer of Penn—for *direct* infringe-

ment of the Sutherland Patent No. 1,539,701, by reason of the use of "Superlite" in treating flour (R. 39-49).

8. Both Penn and the Tex-O-Kan Company raised as a defense in their respective suits that the expired Sutherland Reissue Patent No. 16,116, and the Sutherland patent in suit No. 1,539,701, were for the same invention, and that upon the expiration of the reissue patent on May 31, 1938, the public, of which they were a part, acquired the right to utilize the "process" of mixing edible cereal products with a chemical compound, and to form the alleged "mixture" therebetween, for the purpose of bleaching milling products and improving their baking qualities, whereby neither of the petitioners was guilty of either direct or contributory infringement by the manufacture and sale of the chemical compound or the use thereof for its intended purpose.

9. The two causes were consolidated and tried as one (R. 1).

10. At the conclusion of the trial, Judge ATWELL, on the evidence before him, *found as a fact* that the expired reissue Patent No. 16,116, and the patent in suit were for the same invention, and that the monopoly claimed for the patent in suit (No. 1,539,701) expired with the expiration of the reissue patent on May 31, 1938, wherefore the second Sutherland patent was invalid (R. 236-232). In consequence he decreed the dismissal of the complaints (R. 387, 388).

11. The Fifth Circuit Court of Appeals reversed the judgment of the Texas District Court and sustained the validity of the second Sutherland patent—not because of any asserted error of *fact* based on the *evidence* before it, or any asserted error in *conclusion of law* resulting therefrom

—but *solely* because of the doctrine of *comity,* inasmuch as the Court of Appeals for the Second Circuit, *nearly twelve years ago,* in litigation brought on the same patent against *another* defendant with whom petitioners were in no way connected, and on a wholly *different* record (not before the Fifth Circuit Court of Appeals, physically or otherwise) had passed adversely on a defense of "double patenting" there raised.*

12. This action of the Court of Appeals necessarily involved setting aside and ignoring the *finding of fact* by the District Court that the two patents were for the same invention, in complete disregard of the evidence in the record which supported the finding of the District Court, and without reference to *any* evidence in the case which would support a different conclusion. Indeed, the Court of Appeals baldly substituted the doctrine of comity for evidence, findings of fact and conclusions of law based thereon, whereby petitioners have been held to be bound by a decision rendered nearly twelve years ago in a litigation in which they took no part, and on a record not here before the Court in any manner or form.

13. Because this action of the Court of Appeals has deprived petitioners of their constitutionally guaranteed day in Court, and an adjudication of the merits of the defense *they* have both raised, on the evidence *they* have adduced; and because the Court of Appeals has set aside and ignored the dispositive finding of fact of the Trial Court which should have been regarded as "unassailable"; petitioners seek a review of the decision of the Court of Appeals for the Fifth Circuit and of the question of validity of Sutherland Patent

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Novadel Process Corporation v. *J. P. Meyer & Co.,* 1929, 35 Fed. (2d) 697, C. C. A. 2nd.

No. 1,539,701, in view of the prior patent issued to the same patentee, for the same invention, which expired on May 31, 1938.*

Reasons Relied Upon for the Grant of a Writ of Certiorari.

The discretionary power of this Court is invoked upon the following grounds:

1. Because of the public importance of the subject matter of the case, as well as of the public importance of whether or not the monopoly of a patent which has passed into the public realm by the expiration of the patent, can be continued to be enforced by means of a subsequent, unexpired patent, issued to the same patentee, for the same invention.

2. Because the Court of Appeals for the Fifth Circuit has decided an important Federal question in a way that

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* The suits also involved Kroeber Patent No. 1,555,805. Both of the Courts below held this patent to be invalid. Likewise, there were other defenses raised to the Sutherland patent, as to one of which the Court of Appeals below has directed further proceedings to be had in the District Court. The present petition is concerned with none of those matters, and, if granted, and the error of the Court of Appeals corrected, the review here sought will be completely dispositive of the litigations, requiring the dismissal of the complaints.

is in direct conflict with the applicable decisions of this Court.

3. Because of the irreconcilable conflict of opinions of the Courts below wherein the Court of Appeals has substituted the doctrine of comity for a dispositive finding of fact by the Trial Court, which finding was not and could not have been found to be erroneous on the record before the Court, and should have been regarded as "unassailable".

4. Because petitioners have been deprived of their constitutionally guaranteed right to an adjudication of the sufficiency and justice of their defense to a charge of patent infringement.

WHEREFORE your petitioners respectfully pray that a writ of certiorari issue out of and under the seal of this Court directed to the United States Circuit Court of Appeals for the Fifth Judicial Circuit, commanding said Court to certify and send to this Court, on a day to be designated, a full transcript of the record and all proceedings of the Court of Appeals had in this case, to the end that this case may be reviewed and determined by this Court; and that the judgment of the Court of Appeals be reversed in so far as it found validity for Sutherland Patent No. 1,539,701;

and that petitioners may be granted such other and further relief as may seem proper.

SAMUEL E. DARBY, JR.,
Counsel for Petitioners.

ROBERT A. RITCHIE,
LOUIS D. FLETCHER,
Of Counsel.

Dated: New York, N. Y.
July 1, 1941.